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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,590	10/24/2003	Sunil Kochhar	88265-6820	2216

28765 7590 09/23/2005

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WASHINGTON, DC 20006

EXAMINER

WORLEY, CATHY KINGDON

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,590

Applicant(s)

KOCHHAR ET AL.

Examiner

Cathy K. Worley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4 and 12-18, drawn to an isolated or synthesized cocoa polypeptide identified by SEQ ID NO:1, SEQ ID NO:2, or a fragment thereof comprising SEQ ID NO:3 or SEQ ID NO:4, and a method of producing cocoa or chocolate flavor comprising isolating, synthesizing or producing said polypeptide, and to said method further comprising reacting the peptide with a reducing sugar, classified in class 530, subclass 324, for example.
- II. Claims 5-11 and 19-20, drawn to an isolated or synthesized nucleotide sequence encoding a polypeptide identified by SEQ ID NO:1, SEQ ID NO:2, or a fragment thereof comprising SEQ ID NO:3 or SEQ ID NO:4, and a vector containing said sequence, and a cell containing said sequence or said vector, and a plant containing said cell, and a method of producing cocoa beans with increased cocoa flavor peptides, the method comprising transforming a cocoa cell with said sequence and generating at least one cocoa plant from the transformed cell, classified in class 800, subclass 278, for example.

The inventions are distinct, each from the other because of the following reasons:

The inventions of groups I and II are patentably distinct. The peptides of group I can be made and used without the polynucleotide or method of group II, for instance the peptides of group I can be chemically synthesized or can be purified from cocoa plants.

A search for the peptides and methods of group I would encompass searching amino acid databases and searching for techniques of making and purifying peptides. A search for the polynucleotides and methods of group II would require searching the nucleic acid databases and searching for techniques of making transgenic cocoa plants. These searches are not coextensive, and therefore examining both inventions would constitute an undue burden.

This application contains claims directed to multiple polynucleotide molecules. Each of these are patentably distinct from each other because the polynucleotides are each unique molecules with different chemical and structural features. Applicants are reminded that nucleotide sequences encoding different proteins, and the amino acid sequences they encode, are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide and amino acid sequence is presumed to represent an independent and distinct

invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq.

Applicant is required to select one nucleotide or amino acid sequence from the following:

- A) SEQ ID NOs: 1 and 3, or
- B) SEQ ID NOs: 2 and 4.

Claims that do not read on the elected sequence will be considered withdrawn. Applicant is advised that a reply to this requirement must include an identification of the sequence that is selected. An election that does not identify the sequence selected will be considered nonresponsive. This requirement is not to be construed as an election of species since each nucleotide sequence is not a member of a single genus of invention but constitutes independent and patentably distinct inventions.

A call was made on Sept. 7, 2005 to Robert M. Barrett to request an oral election to the above restriction requirement, but he/she was unable to answer the phone. A message was left on his/her answering machine indicating that if an election was not made by phone by Sept. 9, 2005, then the restriction requirement would be sent in the mail.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cathy K. Worley whose telephone number is (571) 272-8784. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (571) 272-0745. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CKW
Sept. 7, 2005



**ANNE KUBELIK, PH.D.
PRIMARY EXAMINER**